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10/069,026	06/13/2002	Hendrik Antonius Hoogland	294-121 PCT/US	9089

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EXAMINER

OMGBA, ESSAMA

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,026

Applicant(s)

HOOGLAND, HENDRIK
ANTONIUS

Examiner

Essama Omgba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 8-45 is/are pending in the application.
- 4a) Of the above claim(s) 20-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 9-19 and 45 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 11-13 are objected to because of the following informalities: in claim 11, line 2, it is suggested that --the method comprising the steps of:-- be inserted before "placing". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The steps of bringing a retaining element into the blanking opening, cutting a label from the strip of film and taking hold and picking up the label for transfer to a mold need to be positively recited in claim 11.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claim 2, 3, 9, 10, 14-17 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Dobler (US Patent 5,919,414).

With regards to claims 45, 3 and 9, Dobler discloses a method for manufacturing labels from a strip of film 22 for placement in an injection mold (col. 1, lines 4-8), the method comprising placing a first side of a part of a strip of film 22 on a supporting carrier 19 (fig. 5), pressing a retaining element 17 on a second side of the part of the strip of film remote from the carrier 19, the retaining element and the carrier enclosing the part of the strip of film therebetween, holding the part of the strip of film by the retaining element, cutting the part of the strip of film enclosed between the carrier and the retaining element sufficiently to loosen the part of the strip of film to form a label-forming part and removing the label forming part from the carrier, see column 6, lines 3-14 , 45-49 and 56-59 and column 7, lines 5-8.

For claim 2, see column 8, lines 8-11 and figures 6 and 7.

For claim 10, see column 6, lines 63-67 and column 7, lines 1-17.

For claims 14 and 15, it is inherent that the strip of film would be printed prior to the formation of the labels and that the printing would be provided on the second side retained by the retaining element.

For claim 16, see column 5, lines 37-44. It is inherent that the strip of film is held taut therefore the label-forming part would be stretched over the retaining part prior to being taken hold of.

For claim 17, see column 3, lines 60-67 and column 4 lines 1-20.

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6. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimi et al. (US Patent 5,908,590).

Yoshimi et al. discloses a method for manufacturing labels from a strip of film for placement in a mold, the method comprising placing a first side of a part of a strip of film 1 on a supporting carrier 20 overlying a blanking opening 21, bringing a retaining element 23 into the blanking opening, cutting out a label 11 from the strip of film with a blanking punch 22, the label being cut against the retaining element, and taking hold of and picking the label for transfer to a mold, see column 6, lines 26-42.

For claim 12, see column 6, lines 31-34. It is inherent that the retaining element is not loaded during the punching.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobler.

With regards to claim 4, Dobler discloses a method for manufacturing labels as shown above wherein the label-forming part is taken hold of using vacuum means on the retaining element such that the label-forming part is kept taut over the retaining element (column 5, lines 65-67 and column 6, lines 1-2). Although Dobler does not

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disclose the vacuum means extending along the outer contour of the retaining element, however it is within the general knowledge of one of ordinary skill in the art to appropriately dispose the vacuum means on the retaining element in order to keep the label-forming part taut on the retaining element. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided vacuum means extending along the outer contour of the retaining element of Dobler as is within the general knowledge of one of ordinary skill in the art in order to keep the label-forming part taut on the retaining element.

For claims 5 and 6, Dobler discloses a method for manufacturing labels for placement in an injection mold as shown above except for the labels being taken hold of using static charge or adhesion. However it would have been obvious to one of ordinary skill in the art at the time the invention was made that using static charge or adhesion to take hold of the labels on the retaining element is an obvious matter of design choice wherein no stated problem is solved or unexpected results obtained in using static charge or adhesion versus vacuum force as taught by Dobler as long as the label is held on the retaining element without crease.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimi et al.

Yoshimi et al. discloses a method for manufacturing labels for placement in an injection mold as shown above including a blanking punch 22 with a complementary second blanking plate (figure 3). Although Yoshimi et al. discloses the opening integral with the carrier, it would have been obvious to one of ordinary skill in the art that

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providing a blanking plate surrounding the opening is an obvious matter of design choice as long as the opening and the blanking punch are designed to be complementary in efficiently forming the labels.

10. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobler in view of Yoshimi et al.

Dobler discloses a method for manufacturing labels for placement in an injection mold as shown above except for the strip of film having a thickness of less than 30 micrometers. However Yoshimi et al. teaches such strip of film thickness, see column 6, lines 23-24. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a strip of film with the thickness as taught by Yoshimi et al. in the method of Dobler, in order to cheaply manufacture the labels by using less material.

Allowable Subject Matter

11. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments with respect to claims 11, 18 and 19 have been considered but are moot in view of the new ground(s) of rejection.

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13. Applicant's arguments filed on November 22, 2004 regarding claims 4, 16 and 45 have been fully considered but they are not persuasive.

In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which Applicant relies (i.e., the retaining element forms half of the cutting part when used with the carrier) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that the Dobler reference does not teach that the label-forming part is pulled taut or stretched over the retaining element, the examiner respectfully disagrees. Dobler is solving the problem of creases on the label forming part (abstract and column 1, lines 50-54). The examiner submits that it would be impossible to have the label-forming part sagging over the retaining part before being cut from the strip of material and end with a label without creases. Therefore it is inherent that the label-forming part would have to be held taut over the retaining element.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F (10-7:30) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Essama Omgba
Primary Examiner
Art Unit 3726

eo
February 26, 2005